

7-17-07

VIA EFS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Inventor: Katsuya Watanabe §
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Conf. No.: 1679 § Group Art Unit: 2626
§
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Appln. No.: 10/805,965 § Examiner: Thang V. Tran
§
§
Filing Date: March 22, 2004 § Attorney Docket No.: 10407-82US
§ (A3103MT-US1)
Title: METHOD AND APPARATUS FOR RECOGNIZING OPTICAL DISCS, OPTICAL
DISC DRIVE, AND METHOD AND APPARATUS FOR DISTINGUISHING DATA
STORAGE LAYER

REFUND REQUEST

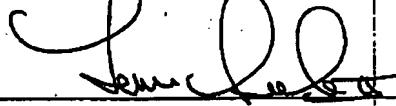
In reference to the above-identified patent application, please note that on June 20, 2007, we filed an Information Disclosure Statement under 37 CFR 1.97(c)1 for which no fee is due. References cited in the Information Disclosure Statement were first cited in a Notice of Reasons for Rejection dated April 10, 2007 from the Japanese Patent Office in Counterpart Japanese Application No. 2004-072514 not more than three months prior to the filing of the Statement. A translation of the Notice of Reasons for Rejection is attached hereto for your convenience.

Upon review of our Deposit Account Statement, it appears that on June 25, 2007, we were erroneously charged \$180.00 for the submission of Information Disclosure Statement (Fee Code 1806). A copy of our Deposit Account Statement is also attached for your convenience.

It is requested at this time that a refund of \$180.00 be applied to the account of Akin Gump Strauss Hauer & Feld LLP, Deposit Account No.50-1017 (Billing No. 210407.0082).

Respectfully submitted,

Katsuya Watanabe et al.



By:

July 16, 2007

Date

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7834100 v1

(Translation)

NOTICE OF REASONS FOR REJECTION

Patent Application No. 2004-072514

Drafting Date: April 2, 2007

Mailing Date: April 10, 2007

Examiner: Masaaki KOKAWA (3242 5D00)

To: Seiji OKUDA, Patent Attorney

Applied Sections of Japanese Patent Law: Sec. 17^{bis} (3), Sec. 29(1), Sec. 29(2) and Sec. 37

The present application is rejected for the following reasons. Any argument must be submitted within 60 days from the mailing date of this document.

REASONS

<REASON A>

The amendments the applicant of the present application submitted on December 22, 2004 fail to comply with the requirements of Sec. 17^{bis} (3) of the Japanese Patent Law in the following respects because those amendments were not made within the scope of the specification or the drawings that had been originally attached to the present application.

REMARKS

The amended claims 25 to 32 of the present application now recite an apparatus for recognizing the type of a given optical disk, which includes "means for changing the focusing angles of a light beam according to the thickness of a light beam passage layer of the optical disk" and a method for recognizing the type of a given optical disk, which includes the step of "changing the focusing angles of a light beam according to the thickness of a light beam passage layer of the optical disk".

However, neither the "means for changing the focusing angles" nor the "step of changing the focusing angles" is described or suggested in the specification and drawings that were originally attached to the present application. Therefore, the amendments were not made within the scope of the originally attached specification and drawings.

It should be noted that since the subject matters of claims 25 to 32 for the amended specification or drawings are clearly outside of the scope of the specification or drawings that were originally attached to the application, the inventions defined by those claims were not examined in terms of novelty, inventive step and other requirements for grant of patent.

<REASON B>

The present application fails to comply with the requirements of Sec. 37 of the Japanese Patent Law on the following points.

REMARKS

The problem to be solved by the inventions defined by claims 1 through 24 of the present application in common is "to minimize collision between the focusing means and the optical disk". However, this problem had already been solved (see Cited Reference #1, for example), and was no longer a problem to be solved, when the present application was filed. For that reason, the inventions defined by claims 1 through 24 of the present application do not comply with the requirement of Sec. 37(i) of the Japanese Patent Law.

Also, to recognize the type of a given optical disk by "the smallest, first one of multiple different numerical apertures", which is a specified technical feature of the present invention that was devised to solve the problem shared by claims 1 through 24 of the present application in common, had already been well known in the art before the present application was filed, as can be seen from Document #1. That is why the inventions defined by claims 1 through 24 of the present application have no characteristic part that defines a novel specified technical feature of the present

invention to solve the problem, and therefore, fail to comply with the requirement of Sec. 37(2) of the Japanese Patent Law.

Besides, the inventions defined by those claims 1 through 24 of the present application do not comply with any of the requirements of Sec. 37(iii), 37(iv) and 37(v) of the Japanese Patent Law.

Since the present application fails to comply with the requirements of Sec. 37 of the Japanese Patent Law, the inventions defined by no claims but claims 1 to 3 were examined in terms of novelty, inventive step, and other requirements for grant of patent.

It should be noted that the inventions defined by claims 4, 5, 7, and 11 through 15 of the present application were examined this time only in terms of novelty, inventive step and other requirements for grant of patent because the Examiner found it efficient to examine those inventions along with that defined by claim 1 of the present application. However, the applicant should take good care in the rest of the prosecution such that the present application satisfies the unity of invention requirement.

<REASON C>

The inventions defined by the following claims of the present application are rejected under Sec. 29(1)(iii) of the Japanese Patent Law as either being anticipated by the following cited references that were published in Japan or in a foreign country, or being available to general public through telecommunications lines, prior to the filing of the present application.

<REASON D>

The inventions defined by the following claims of the present application are rejected under Sec. 29(2) of the Japanese Patent Law as being obvious to those skilled in the art in view of either the subject matter described in the following cited references that were published in Japan or in a foreign country, or the subject matter that was publicly available through an electric telecommunication lines, prior to the filing of the present application.

REMARKS

(As for cited references, see List of Cited References)

Claims 1 to 5, 7 and 11 to 15,

Reasons C and D

Cited References #1 and #2

Notes

Cited Reference #1 discloses an optical disk drive for reading from, and writing to, at least two types of optical disks with mutually different numerical apertures by recognizing the type of a given optical disk with the disk irradiated with a light beam through an objective lens having the smallest numerical aperture (see, in particular, Paragraphs #0008 through #0054 and FIGS. 1 through 20 of Cited Reference #1).

Therefore, there is no significant structural difference between the inventions defined by claims 1 to 4 of the present application and the subject matter of Cited Reference #1.

As for the inventions defined by claims 5 and 7 of the present application, see Paragraph #0026 of Cited Reference #1.

Regarding the inventions defined by claims 11 to 14 of the present application, the wavelength of a light source and the numerical aperture of focusing means in an optical disk drive would have been appropriately determined by those skilled in the art according to the type of the given optical disk.

And as for the invention defined by claim 15 of the present application, Cited Reference #1 teaches recognizing the type of a given optical disk by determining whether the read signal is a desired signal or not (see Paragraph #0026 of Cited Reference #1 and, if necessary, Paragraphs #0096 through #0110 and FIGS. 11 through 14 of Cited Reference #2).

If another reason for rejection is newly found, another notice of reasons for rejection will be sent to the applicant.

LIST OF CITED REFERENCES

1. Japanese Patent Application Laid-Open Publication No. 2002-319150
2. Japanese Patent Application Laid-Open Publication No. 11-306650

拒絶理由通知書

特許出願の番号	特願2004-072514
起案日	平成19年 4月 2日
特許庁審査官	古河 雅輝 3242 5D00
特許出願人代理人	奥田 賢司 様
適用条文	第17条の2第3項、第29条第1項、第29条第2項、第37条

この出願は、次の理由によって拒絶をすべきものである。これについて意見があれば、この通知書の発送の日から60日以内に意見書を提出して下さい。

理由

<理由A>

平成16年12月22日付けでした手続補正は、下記の点で願書に最初に添付した明細書又は図面に記載した事項の範囲内においてしたものでないから、特許法第17条の2第3項に規定する要件を満たしていない。

記

上記補正により、請求項25-32には「光ディスクの光ビーム通過層の厚みに応じて光ビームの集束角度を変化させる集束角度変化手段」を備える判別装置、あるいは「光ディスクの光ビーム通過層の厚みに対応して集束角度を変化させる集束角度変化ステップ」を備える判別方法が記載されている。

しかし、上記「集束角度変化手段」や「集束角度変化ステップ」については、当初明細書及び図面には記載も示唆もされていないから、上記補正是当初明細書及び図面に記載された事項に基づくものではないと認められる。

なお、当該補正がなされた明細書又は図面における請求項25-32に記載した事項は、願書に最初に添付した明細書又は図面に記載した事項の範囲内にないことが明らかであるから、当該請求項に係る発明については新規性、進歩性等の特許要件についての審査を行っていない。

<理由B>

この出願は、下記の点で特許法第37条に規定する要件を満たしていない。

記

請求項1-24に記載される発明に共通する課題は「集束手段と光ディスクとの衝突を低減」することであるが、この課題は、本願出願前に解決されており（例えば、下記文献1参照）、本願出願時未解決の課題ではないから、請求項1-24に記載される発明は特許法第37条第1号の関係を満たさない。

また、上記請求項1-24に記載される発明に共通する解決しようとする課題に対応した発明特定事項である「異なる開口数のうちで最小の第1開口数」で判別する点は、文献1に示すように本願出願前に公知の技術であるから、解決しようとする課題に対応した新規な発明特定事項である主要部が存在せず、上記請求項1-24に記載される発明は、特許法第37条第2号の関係を満たさない。

さらに、上記請求項1-24に記載される発明は、特許法第37条第3号、第4号、第5号に規定する他のいずれの関係も満たさない。

この出願は特許法第37条の規定に違反しているので、請求項1-3以外の請求項に係る発明については新規性、進歩性等の要件についての審査を行っていない。

（なお、請求項4、5、7、11-15に係る発明も、請求項1に係る発明とまとめて審査を行うことが効率的であると判断したので、今回に限り、新規性、進歩性等の要件についても審査を行ったが、以後の手続きにおいては、本願が発明の単一性の要件を満たすものとなるよう留意されたい。）

＜理由C＞

この出願の下記の請求項に係る発明は、その出願前に日本国内又は外国において、頒布された下記の刊行物に記載された発明又は電気通信回線を通じて公衆に利用可能となった発明であるから、特許法第29条第1項第3号に該当し、特許を受けることができない。

＜理由D＞

この出願の下記の請求項に係る発明は、その出願前に日本国内又は外国において、頒布された下記の刊行物に記載された発明又は電気通信回線を通じて公衆に利用可能となった発明に基いて、その出願前にその発明の属する技術の分野における通常の知識を有する者が容易に発明をすることができたものであるから、特許法第29条第2項の規定により特許を受けることができない。

記 （引用文献等については引用文献等一覧参照）

請求項：1-5, 7, 11-15

理由：C, D

引用文献等：1, 2

備考:

引用文献1の特に【0008】-【0054】及び図1-20(特に第一実施形態)には、

異なる開口数に対応する少なくとも2種類の光ディスクを記録再生する光ディスク装置であって、

最小の開口数の対物レンズを介して、光ディスクに対して光ビームを照射し、光ディスクの種類を判別する光ディスク装置が記載されている。

したがって、本願の請求項1-4に係る発明と引用文献1に記載された発明とは、その構成に格別の差異がない。

請求項5、7に係る発明については、同文献の【0026】を参照されたい。

請求項11-14に係る発明について、光ディスク装置における光源の波長や集光手段の開口数をどう設定するかは、記録再生すべき光ディスクに応じて当業者が適宜設計すべき事項に過ぎない。

請求項15に係る発明について、引用文献1の【0026】には、再生信号が所望の信号であるか否かによって光ディスクの判別を行うことが記載されている。(必要であれば、文献2の【0096】-【0110】及び図11-14も参照されたい。)

拒絶の理由が新たに発見された場合には拒絶の理由が通知される。

引用文献等一覧

- 特開2002-319150号公報
- 特開平11-306650号公報

先行技術文献調査結果の記録

・調査した分野 IPC第7版

G11B 7/00-7/22

この先行技術文献調査結果の記録は、拒絶理由を構成するものではない。

この拒絶理由通知の内容に関するお問い合わせがございましたら、下記までご連絡下さい。

記

特許審査第四部 情報記録 古河 雅輝(こかわ まさあき)

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整理番号:2032450308 発送番号:161897 発送日:平成19年 4月10日

4/E

FAX 03 (3580) 6906

Deposit Account Statement

Page 7 of 9

06/21 7352	11722354	052460-36US (MJHF012PCUS)	1642	\$400.00	\$11
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06/26 2205	10601212	0001377USX	1251	\$120.00	\$10
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06/26 3003	29237724	052460-8US(M/ERB-185US)	8001	\$30.00	\$10

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